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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,803	10/21/2003	Shinako Matsuyama		7579
7590	06/08/2005		EXAMINER	
Jay H. Maioli Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/689,803	MATSUYAMA, SHINAKO	
	Examiner	Art Unit	
	Mary Cheung	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 March 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 6-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 October 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. 09/555,850.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to the restriction election filed on March 24, 2005. Claims 6-8 are pending. Claims 1-5 are canceled.

Specification

2. The disclosure is objected to because of the following informalities: In BRIEF DESCRIPTION OF DRAWINGS section, the applicant fails to describe figure 12. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 lines 15-19 recites "said information processing apparatus in a shop encrypting said monetary amount appended with a signature of said user device with said temporary key and transmitting the encrypted monetary amount to said information processing apparatus in a shop". It does not make sense that "said information processing apparatus" transmits the encrypted monetary amount to itself. Furthermore, it is not clear where "said information processing apparatus" gets "a signature of said user device". Does it refer to the signature that is mentioned in line 8 of the claim. If

they are not the same signature, applicant should clarify that how said information processing apparatus obtained "a signature of said user device " as claimed in line 16.

Claims 6 lines 20-21 recites "decrypting said encrypted monetary amount". It is not clear if "said encrypted monetary amount" refers to the encrypted monetary amount mentioned in line 6 or in lines 15-16.

Claim 7 recites the phrase "the monetary amount". It is not clear which monetary amount it refers to since the applicant has claimed numerous times of "monetary amount" in the independent claim 6.

Claim 8 recites the limitation "said number unique to said user device" in lines 15-16. There is insufficient antecedent basis for this limitation in the claim. Applicant is suggested to change the phrase "a number unique to said information processing" in lines 10-11 to "a number unique to said user device" for overcoming this rejection.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 6-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 6-7 only recite an abstract idea. The recited steps of merely transferring money does not apply, involve, use, or advance the technological arts since all of the recited steps **can be performed in the mind of the user or by use of a pencil and paper**. These steps only constitute an idea of how to safely transfer money.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention adding and subtracting monetary amounts (i.e., useful, concrete and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 6-7 are deemed to be directed to non-statutory subject matter. Applicant is advised to implement computer technology into the independent claim 6 in order to overcome the rejections, such as "electronically encrypting a monetary amount...", "electronic transmitting the monetary amount...".

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3621

Bernstein (U. S. Patent 5,915,023) discloses automatic portable controller for remotely arranging for transfer value to a recipient.

Denno et al. (U. S. Patent 6,128,391) discloses asymmetric key management in cryptographic system.

Downs et al. (U. S. Patent 6,226,618) discloses electronic content delivery system.

Davis et al. (U. S. Patent 6,282,522) discloses internet payment system using smart card.

Dent (U. S. Patent 6,311,171) discloses symmetrically-secured electronic communication system.

Camp et al. (U. S. Patent 6,317,729) discloses certifying delivery of secure electronic transactions.

Baba (EP 0 791 901 A2) discloses network transaction system.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is 571-272-6705. The examiner can normally be reached on M-Th (10:00-7:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Cheung
Primary Examiner
Art Unit 3621
June 6, 2005

